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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,096	07/25/2001	Lily C. Li	31021.P004	5562
22971	7590	05/23/2006	EXAMINER	
MICROSOFT CORPORATION ATTN: PATENT GROUP DOCKETING DEPARTMENT ONE MICROSOFT WAY REDMOND, WA 98052-6399			GOLD, AVI M	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,096

Applicant(s)

LI ET AL

Examiner

Avi Gold

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 9, 10, 13-16, 19-21 and 23-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9, 10, 13-16, 19-21 and 23-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the amendment filed on March 21, 2006. Claims 1, 9, 10, 13, 19-21, 23, and 25-45 were amended. Claims 5-8, 11, 12, 17, 18, and 22 were cancelled. Claims 1-4, 9, 10, 13-16, 19-21, and 23-45 are pending.

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 9, 10, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Pollack, U.S. Patent No. 6,505,236.

Pollack teaches the invention as claimed including a system and method which detaches and stores any mail attachments and appends the body of the mail to include a handle to enable the recipient to retrieve the stored attachment at a later time (see abstract).

Regarding claim 1, Pollack teaches a method comprising:

receiving a request to send an email (col. 4, lines 4-6, Pollack discloses a receiving portal to receive an email);

determining whether the email to be sent includes one or more attachments (col. 1, lines 59-62, Pollack discloses multiple attachments on an email);

determining whether a recipient of the email has distributed storage separate from an incoming email server of the recipient for storing email attachments, if the email to be sent includes one or more attachments (col. 4, lines 25-34, Pollack discloses a mail attachment storage system);

determining a network address of the recipient's distributed storage for storing email attachments, if the recipient has such distributed storage (col. 4, lines 34-39, Pollack discloses a storage device that stores attachment at specific address);

determining whether the recipient's distributed storage is available to receive the one or more attachments upon determining the network address (col. 6, lines 39-48, Pollack discloses the use of an attachment comparator to see if an attachment can be received and kept); and

if the recipient has distributed storage for storing email attachments and the distributed storage is available to accept said one or more attachments:

sending a main body of the email to the incoming email server of the recipient (col. 7, lines 1-11, Pollack discloses an email sent without an attachment);

sending an instruction to the recipient's distributed storage to submit a request for one or more attachments of the email (col. 5, lines 50-67, col. 7, lines 1-11, Pollack discloses an attachment receiver); and

upon receipt of such a request, sending the one or more attachments of the email to the recipient's distributed storage for email (col. 4, lines 25-39).

Regarding claims 2 and 14, Pollack teaches the method of claims 1 and 13, wherein said determining of whether the recipient of the email has distributed storage separate from an incoming email server of the recipient for storing email attachments comprises querying a recipient email distributed storage location server (col. 4, lines 25-34).

Regarding claim 3 and 15, Pollack teaches the method of claims 1 and 13, wherein said determining of the network address of the recipient's distributed storage for storing email attachments comprises querying a recipient email distributed storage location server (col. 4, lines 25-39).

Regarding claim 4 and 16, Pollack teaches the method of claims 1 and 13, wherein said determining of whether the recipient's distributed storage is available to receive the one or more attachments comprises pinging the recipient's email distributed storage using said determined network address (col. 4, lines 25-39, col. 6, lines 39-48).

Regarding claim 9, Pollack teaches the method of claim 1, further comprising sending the main body of the email and the one or more attachments of the email to the incoming email server of the recipient if the recipient has distributed storage but the distributed storage is not available to accept said one or more attachments (col. 1, lines

35-45, col. 2, lines 26-57, Pollack discloses an attachment attached directly to an email if no storage is available).

Regarding claim 10, Pollack teaches the method of claim 1, further comprising sending the main body of the email and the one or more attachments of the email to the incoming email server of the recipient if the recipient does not have distributed storage for email attachments (col. 1, lines 35-45, col. 2, lines 26-57).

Regarding claim 13, Pollack teaches a method comprising:

receiving an email on behalf of a recipient, the email including a main body and one or more attachments (col. 1, lines 59-62, col. 4, lines 4-6);

determining whether the recipient of the email has distributed storage for storing email attachments (col. 4, lines 25-34);

determining a network address of the recipient's distributed storage for storing email attachments, if the recipient has such distributed storage (col. 4, lines 34-39);

determining periodically whether the recipient's distributed storage is available to receive the one or more attachments upon determining the network address (col. 6, lines 39-48);

sending an instruction to the recipient's distributed storage to submit a request for the one or more attachments of the email (col. 5, lines 50-67, col. 7, lines 1-11); and

upon such a request, sending the one or more attachments of the email to the recipient's distributed storage for email attachments (col. 4, lines 25-39).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 19-21, and 23-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack, U.S. Patent No. 6,505,236, further in view of Hazan et al., U.S. Patent No. 6,434,602.

Pollack teaches the invention substantially as claimed including a system and method which detaches and stores any mail attachments and appends the body of the mail to include a handle to enable the recipient to retrieve the stored attachment at a later time (see abstract).

Regarding claim 19, Pollack teaches a method comprising:

receiving a registration to register an email user's distributed storage for email attachments (col. 4, lines 25-39);

storing a network address of the email user's distributed storage for email attachments (col. 4, lines 34-39);

receiving a request from a requestor for the network address of the email user's distributed storage for email attachments; and

providing the requestor with the network address of the email user's distributed storage for email attachments (col. 5, lines 50-67, col. 7, lines 1-11).

Pollock fails to teach the limitation further including the user being a part of a peer-to-peer communication system.

However, Hazan teaches a method, apparatus, and article of manufacture for accessing electronic messages (see abstract). Hazan teaches the use of a peer-to-peer network for e-mail (col. 1, lines 11-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pollock in view of Hazan to use a peer-to-peer communication system. One would be motivated to do so because it allows for bandwidth conservation.

Regarding claim 20, Pollack teaches the method of claim 19, wherein the requestor a sender of an email (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 21, Pollack teaches the method of claim 19, wherein the requestor is an email server associated with an email recipient (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 23, Pollack teaches a method comprising:
receiving a request from a user to access an attachment of an email;
determining whether a distributed storage for storing email attachments for the user is accessible, and if so, whether the attachment is stored in said distributed storage (col. 4, lines 25-39, col. 5, lines 50-67, col. 7, lines 1-11); and

retrieving the attachment(col. 5, lines 50-67, col. 7, lines 1-11).

Pollock fails to teach the limitation further including the user being a part of a peer-to-peer communication system.

However, Hazan teaches the use of a peer-to-peer network for e-mail (col. 1, lines 11-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pollock in view of Hazan to use a peer-to-peer communication system. One would be motivated to do so because it allows for bandwidth conservation.

Regarding claim 24 and 42, Pollack teaches the method and apparatus of claims 23 and 41, wherein said determining of whether the user's distributed storage for email attachments is accessible comprises pinging the user's distributed storage for email attachments (col. 4, lines 25-39, col. 6, lines 39-48).

Regarding claim 25 and 43, Pollack teaches the method and apparatus of claims 23 and 41, wherein said retrieving the attachment further comprises retrieving the attachment from the user's distributed storage for storing email attachments if the user's distributed storage for storing email attachments is accessible, and the attachment is stored in the user's distributed storage for storing email attachments (col. 7, lines 1-11).

Regarding claim 26 and 44, Pollack teaches the method and apparatus of claims 23 and 41, wherein retrieving the attachment further comprises retrieving the attachment from an incoming email server of the user if the user's distributed storage for storing email attachments is accessible, and the attachment is not stored in the user's distributed storage for storing email attachments (col. 1, lines 35-45, col. 2, lines 26-57).

Regarding claim 27 and 45, Pollack teaches the method and apparatus of claims 23 and 41, wherein retrieving the attachment further comprises attempting to retrieve the attachment from an incoming email server of the user if the user's distributed storage for storing email attachments is not accessible (col. 1, lines 35-45, col. 2, lines 26-57).

Regarding claim 28, Pollack teaches an apparatus comprising:

- a storage medium having stored therein a plurality of executable programming instructions that, when executed, perform the following steps:
 - receiving a request to send an email to a recipient (col. 4, lines 4-6);
 - determining whether the email to be sent includes one or more attachments (col. 1, lines 59-62);
 - determining whether a recipient of the email has distributed storage separate from an incoming email server of the recipient for storing email attachments, if the email to be sent includes one or more attachments (col. 4, lines 25-34);

determining a network address of the recipient's distributed storage for storing email attachments, if the recipient has such distributed storage (col. 4, lines 34-39),;

determining whether the recipient's distributed storage is available to receive the one or more attachments upon determining the network address (col. 6, lines 39-48);

servicing said request to send said email based at least in part on the results of said determinations (col. 7, lines 1-11); and

a processor coupled to the storage medium to execute the programming instructions (col. 7, lines 35-51, Pollack discloses a processor performing the process).

Pollock fails to teach the limitation further including the user being a part of a peer-to-peer communication system.

However, Hazan teaches the use of a peer-to-peer network for e-mail (col. 1, lines 11-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pollock in view of Hazan to use a peer-to-peer communication system. One would be motivated to do so because it allows for bandwidth conservation.

Regarding claim 29, Pollack teaches the apparatus of claim 28, wherein said programming instructions are further configured to send the one or more attachments of the email to the recipient's distributed storage, if the recipient has distributed storage for storing email attachments, and the distributed storage is available to accept said one or more attachments (col. 7, lines 1-11).

Regarding claim 30, Pollack teaches the apparatus of claim 28, wherein said programming instructions are further configured to send an instruction to the recipient's distributed storage to submit a request for the one or more attachments of the email, if the recipient has distributed storage for storing email attachments, and the distributed storage is available to accept said one or more attachments (col. 5, lines 50-67, col. 7, lines 1-11, Pollack discloses an attachment receiver).

Regarding claim 31, Pollack teaches the apparatus of claim 30, wherein said programming instructions are further configured to send the one or more attachments of the email to the recipient's distributed storage for email attachments upon receipt of a request from the recipient's distributed storage for the one or more attachments of the email (col. 4, lines 25-39).

Regarding claim 32, Pollack teaches the apparatus of claim 28, wherein said programming instructions are further configured to retry to send the one or more attachments of the email to the recipient's distributed storage in accordance with a retry policy, if the recipient has distributed storage and the distributed storage is not immediately available to accept said one or more attachments (col. 6, lines 39-48).

Regarding claim 33, Pollack teaches the apparatus of claim 28, wherein said programming instructions are further configured to send the one or more attachments of

the email to the incoming email server of the recipient if the recipient has distributed storage and the distributed storage is not available to accept said one or more attachments (col. 1, lines 35-45, col. 2, lines 26-57, Pollack discloses an attachment attached directly to an email if no storage is available).

Regarding claim 34, Pollack teaches the apparatus of claim 28, wherein said programming instructions are further configured to send the one or more attachments of the email to the incoming email server of the recipient if the recipient does not have distributed storage for email attachments (col. 1, lines 35-45, col. 2, lines 26-57).

Regarding claim 35, Pollack teaches an apparatus comprising:

storage medium having stored therein a plurality of executable programming instructions that, when executed, perform the following steps:

receiving an email on behalf of a recipient, the email including a main body and one or more attachments (col. 1, lines 59-62, col. 4, lines 4-6),

determining whether the recipient of the email has distributed storage for storing email attachments (col. 4, lines 25-34),

determining a network address of the recipient's distributed storage for storing email attachments, if the recipient has such distributed storage (col. 4, lines 34-39),

periodically determining whether the recipient's distributed storage is available to receive the one or more attachments upon determining the network address (col. 6, lines 39-48), and

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sending the one or more attachments of the email to the recipient's distributed storage for email attachments for storage, upon determining that the recipient's distributed storage for email attachments is available to accept email attachments (col. 4, lines 35-39); and

a processor coupled to the storage medium to execute the programming instructions (col. 7, lines 35-51).

Pollock fails to teach the limitation further including the user being a part of a peer-to-peer communication system.

However, Hazan teaches the use of a peer-to-peer network for e-mail (col. 1, lines 11-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pollock in view of Hazan to use a peer-to-peer communication system. One would be motivated to do so because it allows for bandwidth conservation.

Regarding claim 36, Pollack teaches the apparatus of claim 35, wherein said programming instructions are further configured to send an instruction to the recipient's distributed storage for email attachments, instructing the recipient's distributed storage for email attachments to submit a request for the one or more attachments of the email (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 37, Pollack teaches the apparatus of claim 36, wherein said programming instructions are further configured to send the one or more attachments of the email to the recipient's distributed storage for email attachments upon receipt of a request from the recipient's distributed storage for the one or more attachments of the email (col. 4, lines 25-39).

Regarding claim 38, Pollack teaches an apparatus comprising:

a storage medium having stored therein a plurality of executable programming instructions that, when executed, perform the following steps:

receiving a registration to register an email user's distributed storage for email attachments (col. 4, lines 25-39),

storing a network address of the email user's distributed storage for email attachments (col. 4, lines 34-39),

receiving a request from a requestor for the network address of the email user's distributed storage for email attachments, and

providing the requestor with the network address of the email user's distributed storage for email attachments (col. 5, lines 50-67, col. 7, lines 1-11); and

a processor coupled to the storage medium to execute the programming instructions (col. 7, lines 35-51).

Pollock fails to teach the limitation further including the user being a part of a peer-to-peer communication system.

However, Hazan teaches the use of a peer-to-peer network for e-mail (col. 1, lines 11-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pollock in view of Hazan to use a peer-to-peer communication system. One would be motivated to do so because it allows for bandwidth conservation.

Regarding claim 39, Pollack teaches an apparatus comprising:

a storage medium having stored therein a plurality of executable programming instructions that, when executed:

receiving a request from a selected one of a sender and an incoming email server of a user to pull an attachment of an email,

submitting, in response, a request to the selected one of the sender and the incoming email server of the user to pull said email attachment,

receiving said email attachment, and

storing said email attachment (col. 5, lines 50-67, col. 7, lines 1-11); and

a processor coupled to the storage medium to execute the programming instructions (col. 7, lines 35-51).

Pollock fails to teach the limitation further including the user being a part of a peer-to-peer communication system.

However, Hazan teaches the use of a peer-to-peer network for e-mail (col. 1, lines 11-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pollock in view of Hazan to use a peer-to-peer communication system. One would be motivated to do so because it allows for bandwidth conservation.

Regarding claim 40, Pollack teaches the apparatus of claim 39, wherein the programming instructions are further configured to perform the following additional steps:

- receiving a request from a requestor for the email attachment;
- retrieving the email attachment from storage; and
- providing the retrieved email attachment to the requestor upon successfully retrieving said email attachment from storage (col. 5, lines 50-67, col. 7, lines 1-11).

Regarding claim 41, Pollack teaches an apparatus comprising:
a storage medium having stored therein a plurality of executable programming instructions that, when executed, perform the following steps:

- receiving a request from a user to access an attachment of an email,
- determining whether a distributed storage for storing email attachments for the user is accessible,
- determining whether the attachment is stored in said distributed storage if said distributed storage is accessible, and

servicing said request to access said attachment of said email based at least in part on the result of said determination (col. 5, lines 50-67, col. 7, lines 1-11); and a processor coupled to the storage medium to execute the programming instructions (col. 7, lines 35-51).

Pollock fails to teach the limitation further including the user being a part of a peer-to-peer communication system.

However, Hazan teaches the use of a peer-to-peer network for e-mail (col. 1, lines 11-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Pollock in view of Hazan to use a peer-to-peer communication system. One would be motivated to do so because it allows for bandwidth conservation.

Response to Arguments

5. Applicant's arguments with respect to claims 1-4, 9, 10, 13-16, 19-21, and 23-45 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,903,723 to Beck et al.

U.S. Pat. No. 6,839,741 to Tsai

U.S. Pat. No. 6,651,087 to Dennis

U.S. Pat. No. 5,771,355 to Kuzma

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002.

The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

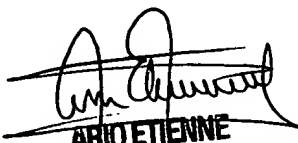
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Avi Gold

Patent Examiner

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AMG


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